

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Board of Patent Appeals and Interferences

Appellants: Matthew W. Hickey, James H. Wolfston, Raymond L. Price
Application No.: 10/003,471
Filing Date: October 31, 2001
Title: Scholarship Award Method
Examiner: Jean D. Janvier
Art Unit: 3688

APPELLANTS' REPLY BRIEF

In accordance with 37 C.F.R. § 41.41, Appellants hereby submit this Reply Brief in response to the Examiner's Answer dated April 16, 2010, in furtherance of the Appeal Brief filed January 12, 2010. The Notice of Appeal was filed in this case on August 12, 2009, and received by the U.S. Patent and Trademark Office on August 12, 2009.

CERTIFICATE OF TRANSMISSION UNDER 37 C.F.R. 1.8

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office, on the date shown below.

On: June 16, 2010

By: /david griner/

Name: David Griner

Telephone Number: (512) 637-0800

RESPONSE TO EXAMINER'S ANSWER

Appellant's Original Appeal Brief was filed January 12, 2010, and the Examiner filed an original Examiner's Answer on April 16, 2010.

Most of the Arguments raised in the Examiner's Answer are identical to his arguments in the Final Office Action. Those arguments are not addressed in this Reply Brief since Appellants' Appeal Brief of January 12, 2010, responds to each of those arguments and rejections. The failure to address these issues again in this Reply Brief does not indicate agreement with or concession on any issue. However, Appellants would like to address several issues raised in the Examiner's Answer.

A. Whether Claims 19, 25, 27, 29, 30, 36, 38, 39 and 40 are indefinite under 35 USC § 112

Appellant respectfully notes that the rejection of Claims 19, 25, 27, 29, 30, 36, 38, 39 and 40 as being indefinite under 35 U.S.C. § 112 has been withdrawn in the Examiner's Answer.

B. Whether Claims 19-29 and 30-40 are unpatentable under 35 USC § 103(a) over Ireland

Claims 19-29 and 30-40 stand rejected under 35 USC § 103(a) as being unpatentable over Ireland, U.S. Pat. No. 7,062,462. Appellants submit that the rejected claims all contain limitations which are not described or taught by the cited reference. Further, the Examiner has failed to provide any reasonable rationale supporting the combination of references.

1. *The Ireland reference, when combined with official notice, does not teach all of the elements of the rejected claims.*

Appellants argue that the proposed combination of Ireland and the Official Notice taken by the examiner do not teach all of the elements of the rejected claims and therefore do not

support a rejection under 35 U.S.C. § 103. The Examiner responds to Appellants argument in the Examiner's Answer at page 15 as follows:

"Ireland does teach a process for allowing parents and/or prospective college students to receive online via a web site through an electronic screen, among other things, educational financial information, regarding a particular university, which contains details for financial aid award package, details on the sources of funds for the award package, namely grants (e.g., Federal Pell grant, Federal SEOG, State grants) scholarships (e.g., institutional scholarships, non-institutional scholarships, State scholarships, private scholarships, etc.) and so on (col. 7:41 to col. 8:6)."

That is, Ireland teaches a method for providing scholarship information to prospective students. However, providing scholarship information to prospective students is not an element of the rejected claims. In fact, as pointed out in Appellant's Appeal Brief, the Examiner expressly admitted in the Final Office Action that Ireland does not teach any of the elements of independent claim 19. The Examiner repeats this admission in the Examiner's Answer. Appellants provided a chart, reproduced below for convenience, showing all of the elements of independent claim 19 along with the Examiner's corresponding statement that Ireland does not teach that limitation.

Claim 19	Ireland – according to the Examiner
19. A method of attracting visitors to a college-related web site, comprising:	"Ireland discloses a method of providing a user with education financing information" Final Office Action at 6.
executing web server software on a server to provide a form on the web site for display on a client computer for use in nominating a college student or prospective college student for potential receipt of a scholarship;	"does not expressly disclose nominating (by a member of the general public) ... one or more scholarship recipients (nominees) via an online form available at a web site (providing a form on a web site to nominate a scholarship recipient)"
receiving by the server the completed form nominating a college student or prospective college;	Final Office Action at 14.
executing web server software on a server to provide a form on the web site for display on a client computer through which a nominee or a member of the general public can cast a vote for one or more nominees;	"does not expressly disclose ... voting for one or more scholarship recipients (nominees) via an online form available at a web site" and does not expressly disclose "providing a form on the web site to a nominee or members of the public to vote for other nominees or himself/herself"
receiving by the server the completed form casting the vote for the one or more nominees;	Final Office Action at 14.
at the end of a given period, determining from the vote cast a scholarship winner or scholarship winners from among the nominees according to the number of votes cast by the general public for those winners; and	does not expressly disclose "awarding a scholarship to the (first) recipient or nominee who receives the most votes or a pre-determined number of votes at the end of a voting period (beyond which votes cannot be submitted or counted)" Final Office Action at 14.
posting an announcement of the winner on the web site.	does not expressly disclose "posting an announcement of a scholarship winner on the web site." Final Office Action at 14.

In the Examiner's Answer at page 16, the Examiner responds to Appellants' assertion that Ireland teaches none of these limitations by arguing that the rejection is not based entirely upon official notice "since Ireland does disclose providing, among other things, scholarship information to prospective college students and Ireland's disclosure is in the same field of

endeavor as the present Application." Of course, the problem with this argument is that "providing . . . scholarship information to prospective students" is not an element of the rejected claims. Further, the fact that Ireland may be "in the same field of endeavor as the present Application" might be relevant to the issue of whether Ireland is analogous art, but it has no relevance whatsoever on the issue of whether Ireland teaches any of the limitations in the rejected claims. Even after acknowledging again that Ireland does not teach "providing a scholarship to a prospective college student or recipient based on a voting process or determining a scholarship winner based on the number of votes cast on behalf of a prospective college student," the Examiner continues to rely on Official Notice to "address the deficiency" of Ireland—in other words, to supply all of the limitations of the rejected claims.

Appellants note that the Examiner's answer is largely identical to the Final Office Action and still contains the Examiner's completely unsupported allegations that various types of internet voting were known before the priority date of Appellants' application. Despite repeated requests by Appellants, the Examiner has never provided any evidence or prior art supporting this allegation. In the responsive portions of the Examiner's answer, the Examiner appears to concede this point and argues only that the general concept of voting was known.

Thus, the Examiner states, "the crux of the 'Official Notice' is that voting or nominating a person for a position is well-known and has been in practiced [sic] for years well before November 2000." *Examiner's Answer* at 16. However, voting or nominating a person for a position is not by itself an element of the rejected claims. Instead, the rejected claims require providing a form on a web site for display on a client computer for use in nominating a college student or prospective college student for potential receipt of a scholarship and providing a form on a web site for display on a client computer through which a nominee or a member of the

general public can cast a vote for one or more nominees for the scholarship. In the Examiner's Answer, as in the Office Actions throughout the prosecution of this case, it is clear that the Examiner has concluded that because the general concepts of scholarships and voting were known, there can be no non-obvious invention involving scholarships and voting. This is obviously not the case or else nothing would ever be patentable. The question is not whether the "crux" of a claim was known (as repeatedly asserted by the Examiner), or even whether each individual word or phrase in a claim was known, but rather whether the claimed invention as a whole would have been obvious to a person of ordinary skill at the time of the invention.

There is absolutely no teaching in Ireland, alone or in combination with the Office Notice taken by the Examiner, of using online voting to nominate and award a scholarship to a prospective college student as claimed. And no person of ordinary skill in the art, without having read Appellants' Specification, would arrive at the invention described in Appellants' claims through a combination of the Ireland reference and the concepts found in the Examiner's "Official Notice." Therefore, Ireland, alone or in combination with the Office Notice, does not support a rejection of Claims 19-29 and 30-40 under 35 U.S.C. § 103.

2. *Ireland does not "implicitly" teach any of the elements of the rejected claims.*

Given that Ireland does not expressly teach any of the elements of the rejected claims, in the Examiner's Answer he argues for the first time that Ireland "implicitly" teaches the missing elements. However, "the test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000)., 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317

(Fed. Cir. 2000).

According to the Examiner, Ireland implicitly teaches "providing a form for use in nominating a scholarship recipient nominee (as recited in claim 28)." Appellant first notes that this limitation is not found in claim 28 at all. In fact, this limitation is not found in any of the rejected claims. The closest language is found in independent claim 30 (similar language is also found in independent claim 19) which requires "providing a form on the web site for display on a client computer for use in nominating a college student or prospective college student for potential receipt of a scholarship."

In support of his argument for implicit disclosure, the Examiner states, "Ireland discloses a system wherein following a clearing process, a school administrator 60, from a particular school, preferably mails a letter to a potential student 50, which contains an announcement that a financial aid award package, including a scholarship award, has been granted to that student 50, meeting or satisfying one or more conditions or requirements or criteria (e.g. the student 50 has applied to the school), and may be obtained by visiting the website on the computer network 20." *Examiner's Answer* at 19 (emphasis omitted). Apparently, the Examiner feels that this implicitly discloses that some sort of form was used to nominate the student.

But even if this were true, that is not all that the claim limitation requires. The actual rejected claim requires "providing a form on the web site for display on a client computer for use in nominating a college student or prospective college student for potential receipt of a scholarship." Ireland says nothing about providing any kind of nomination form on a web site and nothing in the reference or in the "knowledge of one of ordinary skill in the art, [or] the nature of the problem to be solved" would have suggested providing a nomination form on a web site to a person of skill in the art.

Nevertheless, the Examiner concludes that,

"Ireland implicitly supports the steps of selecting an award recipient or scholarship recipient, after a clearing process (which may include a voting process), based on one or more criteria that are not clearly identified or specified (by Ireland). At this point, although Ireland does not expressly recite the voting concept as featured above, however, that limitation is well documented in the art or practiced in the industry for many years (e.g. voting in US political elections) well before the Appellant's invention and are featured here in the 'Official Notice'."

Examiner's Answer at 20. However, Ireland merely discloses a method for informing a student of a financial aid package, and making changes to the packager, after the financial aid package has been awarded. See, e.g., *Ireland* at col. 6, lines 20-23 and FIG. 2C, "award package."

Appellants respectfully submit that Ireland is completely silent as to what steps are actually taken to select the award recipient or scholarship recipient. Furthermore, Appellants have shown that, in the prior art, scholarships are commonly awarded based on a variety of criteria including financial need, academic achievement, and athletic achievement, none of which would attract interested parties to a web site. See, e.g., *Specification* at paragraph 0003. There is absolutely no teaching in Ireland of what comprises the "clearing process" referenced by the Examiner, or that the clearing process includes any method other than the well-known prior art methods for awarding scholarships.

The Examiner goes on to "remind the Appellant that an automation of a well-known or well-established business method does not by itself constitute patentable subject matter." This comment is curious for a number of reasons. First, Appellants' claims are not directed at automating any kind of process whatsoever. Instead, claims 19-29 are directed at a method of attracting visitors to a college-related web site and claims 30-40 are directed at a computer system. Also, providing a form on a web site, as actually required by the rejected claims, has nothing to do with automation. There is nothing in the claim at all that specifies whether any of

the steps must be carried out automatically or whether they can be instituted manually.

Finally, Appellants note that the Examiner fails to provide any other examples of claim limitations that are implicitly taught by Ireland.

3. *No reason to combine the references in the fashion claimed.*

In Appellants' Appeal Brief, Appellants explained how the Examiner has failed to articulate any reasoning with some rational underpinning as to why a person of ordinary skill in the art would combine Ireland's method for providing scholarship information to prospective students with the concept of voting in general to achieve Appellants' rejected claims. In his Answer, the Examiner merely repeats the same purported rationale from the Final Office Action. On page 20 of the Examiner's Answer, however, the Examiner states that "incorporating the 'Official Notice' into the system of Ireland does indeed render the claimed invention obvious by improving, via a voting process, the selection or clearing process used to select a financial award recipient or scholarship recipient, while making the selecting or clearing process fair and square." To the extent that this statement is intended to provide a rationale to combine or modify the references, it also fails to articulate an acceptable rationale.

The Examiner fails to explain how a person of ordinary skill would have considered the inclusion of a voting process to be an improvement of the selection or clearing process used to select a financial award recipient or scholarship recipient. Traditional methods of awarding scholarships or financial aid are based upon merit or financial need. In contrast, the voting process described and claimed by Appellants essentially turns the process into a popularity contest, with the voters being biased in favor of their friends or family. The Examiner fails to explain why any person of ordinary skill in the art would consider this an improvement.

Further, the Examiner fails to explain how his proposed modification of the references would have made the selecting or clearing process "fair and square." There is nothing to indicate that the prior art selection process would have been less fair than a process where the selection is made by voting on the scholarship recipient. The typical method of awarding scholarships via a selection process by a committee of unbiased experts would clearly be more "fair and square" than a process where the scholarship is awarded based on a nominee's popularity with voters.

Therefore, the Examiner has still failed to articulate any reasoning with a rational underpinning as to why a person of ordinary skill in the art would combine Ireland's method for providing scholarship information to prospective students with the concept of voting in general to achieve Appellants' claims directed toward using online voting to nominate and award a scholarship to a prospective college student. Accordingly, the Examiner has not made a *prima facie* case of obviousness support a rejection of Claims 19-29 and 30-40 under 35 U.S.C. § 103.

CONCLUSION

For reasons articulated in this Reply Brief, as well as for the reasons set forth in Appellants' Appeal Brief, it is respectfully requested that the Board reverse the Examiner's rejections of Appellants' claims and allow the application to issue.

If the Commissioner determines that any additional fees or extensions are required,
Applicant requests that such extensions be granted and any fees be charged to Deposit Account
50-1635.

Respectfully submitted,

Date: June 16, 2010

By: /david griner/

David Griner
Pat. Reg. No. 47,614
Scheinberg & Griner, LLP
P.O. Box 164140
Austin, TX 78716-4140
Tel: (512) 637-0800
Fax: (512) 306-1963